

REMARKS

Claims 1-26 are pending in the application. Claims 1 and 14 are independent.

Rejections under 35 U.S.C. § 103

The Patent Office rejected claims 1-26 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,073,003 to Clark (hereinafter referred to as "Clark"). Applicant respectfully traverses the Patent Office's rejection.

The Patent Office indicated that Clark discloses an optoelectronic package comprising a base chip having a v-groove and a fiber array having a v-groove formed in the front and rear portion of the array. Applicant respectfully submits that, contrary to the Patent Office's characterization, Clark discloses only an upper monocrystalline element having a v-groove etched in its upper surface. (Figs. 1, 4, 6 and 7, Col. 3, lines 6 - 38) Applicant's counsel has analyzed the Clark patent and can not find any teaching or suggestion of a base chip having a v-groove as claimed in each of the independent claims of the present application. Furthermore, the v-groove in the upper silicon element 17 of Clark is disposed in a top surface that does not abut any surface of the base chip. (Figs. 1, 4, 6 and 7) Therefore, even the addition of v-grooves to the base chip of Clark could not suggest the arrangement including "a base chip... comprising a base chip v-groove" ...where an optical fiber is "disposed in both v-grooves to substantially couple the chip and array" as claimed in independent claims 1 and 14.

"In order to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Applicant's disclosure." MPEP 2142 citing In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Since Clark, when considered alone or when combined with knowledge of persons having ordinary skill in the art, does not teach or such or suggest the present invention as claimed in any of the claims in the present application, Applicant respectfully submits that the Patent Office has not made a *prima facie* case of obviousness. Accordingly, the rejections under 35 U.S.C. §103 (a) should be withdrawn. Independent claims 1 and 14 and their dependent claims are now allowable.

In view of the above, allowance of this application is now believed to be in order, and such action is hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, she is kindly requested to contact the undersigned at the telephone number listed below. The Examiner is invited and encouraged to telephone the undersigned with any concerns in furtherance of the prosecution of the present application.

Please charge any deficiency as well as any other fees which may become due at any time during the pendency of this application, or credit any overpayment of such fees to deposit account No. 50-0369. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge deposit account No. 50-0369 therefore.

Respectfully submitted,

February 24, 2003
Dated:

Maria Eliseeva
Maria M. Eliseeva, Reg. No. 43,328
Attorney for Applicant
BROWN RUDNICK BERLACK ISRAELS LLP
Box IP, 18th Floor
One Financial Center
Boston, MA 02111
Tel: 1-617-856-8340
Fax: 1-617 856-8201